

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte STUART E. ZATLIN

Appeal No. 2002-1250
Application No. 09/200,057

ON BRIEF

Before ABRAMS, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3, 4, 6 to 9, 18 and 19, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to a method of heading a soccer ball. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Ryan	3,341,201	Sep. 12, 1967
Mitchell	4,462,590	July 31, 1984
Romero	4,698,852	Oct. 13, 1987
Ashinoff	4,947,488	Aug. 14, 1990
Rife et al. (Rife)	5,111,366	May 5, 1992
Horn	5,718,245	Feb. 17, 1998

In addition to the prior art references set forth above, the examiner also relied upon the following non-prior art reference in rejecting the appealed claims:

Mech Site - Table of Coefficient Of Friction Values (Feb. 22, 2001)

Claims 1, 3, 4, 6 to 9, 18 and 19 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.¹

¹ It appears that dependent claims 3, 4 and 6 to 9 were intended to be included in this rejection. See page 3, line 14, of the February 27, 2001 Office action.

Claims 1, 3, 4, 6 to 9, 18 and 19 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.²

Claims 1, 3, 4, 6 to 9, 18 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ryan in view of Mitchell and Horn.

Claims 1, 3, 4, 6 to 9, 18 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Romero in view of Mech Site, Horn and Rife.

Claims 1, 3 and 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ashinoff in view of Romero and Mech Site.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the fifth Office action (Paper No. 16, mailed February 27, 2001) and the answer (Paper No. 19, mailed July 5, 2001) for the examiner's complete reasoning in support of the rejections,

² It appears to us that dependent claims 3, 4 and 6 to 9 were intended to be included in this rejection as in the rejection under the first paragraph of 35 U.S.C. § 112.

and to the supplemental brief (Paper No. 18, filed April 6, 2001) and reply brief (Paper No. 20, filed September 12, 2001) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

We will not sustain the rejection of claims 1, 3, 4, 6 to 9, 18 and 19 under 35 U.S.C. § 112, second paragraph.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented can be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is inappropriate.

Furthermore, the appellant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the Court in In re Swinehart, 439 F.2d 210, 213-14, 169 USPQ 226, 228-29 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

With this as background, we analyze the specific rejection under 35 U.S.C. § 112, second paragraph, made by the examiner of the claims on appeal.

The examiner determined (answer, p. 4) that the phrase "the first coefficient of friction being greater than the second coefficient of friction" as recited in independent claims 1, 18 and 19 was indefinite since the specification fails to provide any information which would permit one skilled in the art to understand the metes and bounds of the claimed invention. The examiner then stated that the term "coefficient of friction" is vague (e.g., does it refer to static coefficient of friction or kinetic coefficient of friction).

The appellant argues (supplemental brief, p. 6) that the above-noted phrase is clear and unambiguous. We agree. In our view, the claimed phrase "the first coefficient of friction being greater than the second coefficient of friction" clearly means just what it says. That is, the coefficient of friction of the friction member is greater than the coefficient of friction of the guarding member. Furthermore, we note that the mere breadth of a claim (e.g., whether the claimed coefficient of friction is static coefficient of friction or kinetic coefficient of friction) does not in and of itself make a claim indefinite.³

For the reasons set forth above, the decision of the examiner to reject claims 1, 3, 4, 6 to 9, 18 and 19 under 35 U.S.C. § 112, second paragraph, is reversed.

³ Breadth of a claim is not to be equated with indefiniteness. See In re Miller, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971).

The enablement rejection

We will not sustain the rejection of claims 1, 3, 4, 6 to 9, 18 and 19 under 35 U.S.C. § 112, first paragraph.

An analysis of whether the claims under appeal are supported by an enabling disclosure requires a determination of whether that disclosure contained sufficient information regarding the subject matter of the appealed claims as to enable one skilled in the pertinent art to make and use the claimed invention. The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. See United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

In order to make a nonenablement rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. See In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A disclosure which contains a teaching of the manner and process of making and using

an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis. See In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). As stated by the court,

it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.

In re Marzocchi, 439 F.2d at 224, 169 USPQ at 370.

The dispositive issue is whether the appellant's disclosure, considering the level of ordinary skill in the art as of the date of the appellant's application, would have enabled a person of such skill to make and use the appellant's invention without undue experimentation. The threshold step in resolving this issue as set forth supra is to determine whether the examiner has met his burden of proof by advancing acceptable reasoning inconsistent with enablement. This the examiner has not done for the reasons set forth in the supplemental brief (pp. 4-6) and reply brief (pp. 1-2).

The examiner determined (answer, p. 3) that a head band using materials with two different coefficients of friction was not enabled by the specification. We disagree. The specification (p. 6) clearly teaches (1) a head band using soft vinyl for the friction member and PVC for the rigid guarding member; and (2) that the friction member has a higher coefficient of friction than the guarding member (i.e., the first coefficient of friction being greater than the second coefficient of friction). This, is sufficient, in our view, to enable one skilled in the art to make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation.

For the reasons set forth above, the decision of the examiner to reject claims 1, 3, 4, 6 to 9, 18 and 19 under 35 U.S.C. § 112, first paragraph, is reversed.

The obviousness rejection utilizing Ryan

We will not sustain the rejection of claims 1, 3, 4, 6 to 9, 18 and 19 under 35 U.S.C. § 103 as being unpatentable over Ryan in view of Mitchell and Horn.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

We do not agree with the examiner that the combined teachings of the applied prior art would have suggested the claimed invention to one of ordinary skill in the art. Specifically, we fail to see any teaching, suggestion or motivation in the applied prior art to have employed the soccer ball of Mitchell with the head rebounding device of Ryan as proposed by the examiner (answer, p. 4). In our view, the only suggestion for modifying Ryan in the manner proposed by the examiner to arrive at the claimed method of heading a soccer ball stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that the decision of the examiner to reject claims 1, 3, 4, 6 to 9, 18 and 19 under 35 U.S.C. § 103 as being unpatentable over Ryan in view of Mitchell and Horn is reversed.

The obviousness rejection utilizing Romero

We will not sustain the rejection of claims 1, 3, 4, 6 to 9, 18 and 19 under 35 U.S.C. § 103 as being unpatentable over Romero in view of Mech Site, Horn and Rife.

We do not agree with the examiner that the combined teachings of the applied prior art would have suggested the claimed invention to one of ordinary skill in the art. Specifically, even if the head guard of Romero were to be modified as proposed by the examiner (answer, p. 6) it would not arrive at the claimed invention. All the claims under appeal require the protective body of the head-protecting apparatus to include a generally rigid guarding member adapted to cover at least a portion of the player's head. However, this limitation is not suggested by the applied art. The examiner's position that the claimed generally rigid guarding member is met by Romero's layer 17 is without merit. Romero does not disclose that layer 17 is generally rigid. Romero does teach (column 3, lines 22-23) that layer 17 can be a soft suede-like material (i.e., non-rigid). It follows that the decision of the examiner to reject claims 1, 3, 4, 6 to 9, 18 and 19 under 35 U.S.C. § 103 as being unpatentable over Romero in view of Mech Site, Horn and Rife is reversed.

The obviousness rejection utilizing Ashinoff

We sustain the rejection of claims 1, 3 and 4 under 35 U.S.C. § 103 as being unpatentable over Ashinoff in view of Romero and Mech Site.

The basis of this rejection is set forth in the fifth Office action (pp. 7-8) and the answer (pp. 7-8).

The sole argument presented by the appellant (supplemental brief, pp. 18-19) against this rejection is that there is no disclosure, motivation, suggestion or teaching in the applied art to use Ashinoff's forehead guard to head a soccer ball. We do not agree. In our view, the combined teachings of Ashinoff and Romero do provide the necessary disclosure, motivation, suggestion and/or teaching to a person of ordinary skill in the art at the time the invention was made to have used Ashinoff's forehead guard to head a soccer ball.

Ashinoff's invention relates to a protective guard worn on a user's forehead, particularly to prevent reinjury to a previously sustained forehead trauma. The forehead guard consists of a closed loop of a terrycloth or similar stretch material tube and an unattached semi-circular plastic shock-absorbing member within the tube adapted to assume a forehead position on the user while the terrycloth tube is stretched about the back of the user's head to complete the positioning thereof. Ashinoff teaches (column 2, lines 13-21) that

most active people, particularly those in sports, invariably experience a painful cut, bruise, bump, laceration, contusion, have surgery or a skin eruption in a specific area of the forehead 12, herein designated 14. At some point during convalescence, the person will wish to resume a high level of activity, but fears reinjury to the recovering forehead location 14. Guard 10 is designed primarily to protect the tender area 14 from reinjury.

Romero discloses a head guard for a soccer player. The head guard minimizes injury which can occur to the forehead of a player when contacted by a soccer ball. The head guard also enables a player to more readily control a soccer ball when bunting the ball with his head. Romero teaches (column 1, lines 27-46) that

During a game of soccer, a player has occasion to "bunt" an airborne, rotating soccer ball with his forehead. Since a soccer ball typically moves through the air at a substantial velocity, controlling the ball while it is bunted with the forehead is difficult. After a player has been actively moving about a soccer field during a match, perspiration on the head of the player increases the difficulty a player has in controlling the ball during bunting. In addition, when a soccer ball contacts the forehead of a player, the ball imparts compressive and shear forces which can cause tears and can break capillaries in the flesh covering the skull bone of the player.

Accordingly, it would be highly desirable to provide improved apparatus which would, during bunting of a soccer ball, protect the head of a soccer player and facilitate a player's controlling the soccer ball.

Therefore, it is a principal object of the invention to provide improved apparatus for protecting the head of a player during bunting of a soccer ball.

In our view, the above-noted teachings of Ashinoff and Romero provide sufficient motivation to have made it obvious at the time the invention was made to a person of ordinary skill in the art to have used Ashinoff's forehead guard to head a soccer ball. In that regard, Ashinoff specifically teaches that a sports player should wear the forehead guard when the sports player fears reinjury to a recovering forehead and Romero teaches and suggests that a head guard be worn to protect a soccer player heading a

soccer ball. Thus, the combined teachings are suggestion of wearing Ashinoff's forehead guard while heading a soccer ball.

For the reasons set forth above, the decision of the examiner to reject claims 1, 3 and 4 under 35 U.S.C. § 103 as being unpatentable over Ashinoff in view of Romero and Mech Site is affirmed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3, 4, 6 to 9, 18 and 19 under 35 U.S.C. § 112, first and second paragraphs, is reversed; the decision of the examiner to reject claims 6 to 9, 18 and 19 under 35 U.S.C. § 103 is reversed; and the decision of the examiner to reject claims 1, 3 and 4 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

NEAL E. ABRAMS
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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